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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/001,256 | 11/02/2001 | Kazuaki Watanabe | U 013696-2 | 8327 |
| 7590 06/01/2004 | | | | |
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| EXAMINER SHOSHO, CALLIE E | | | | |
| ART UNIT | | PAPER NUMBER | | |

1714

DATE MAILED: 06/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/001,256

Applicant(s)

WATANABE ET AL.

Examiner

Callie E. Shosho

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

THE REPLY FILED 10 May 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY (check either a) or b))

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 708.07(f).

Extensions of time may be obtained under 37 CFR 1.136(e). The date on which the petition under 37 CFR 1.136(e) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): 35 USC 112 2nd paragraph rejection.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: g.Claim(s) rejected: 1, 3, 5 and 8-10.

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Callie E. Shosho
Primary Examiner
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Attachment to Advisory Action

1. Applicants' amendment filed 5/10/04 has been considered. The amendment overcomes the 35 USC 112, 2nd paragraph rejection of record with respect to claim 5. However, the amendment and arguments do not overcome the 35 USC 103 rejections of record, namely, JP 11217525 in view of Sano et al. (U.S. 5,769,930) or Anton et al. (U.S. 5,912,280) in view of Sano et al. (U.S. 5,769,930),

Specifically, previously examiner argued that although the 1.132 declaration filed 11/12/03 shows that ink of present invention is superior in terms of cohesion, gloss, fixing ability, bronzing, and ejection stability, the declaration was not successful in establishing unexpected or surprising results over the cited prior art, given that Sano et al. already recognize the criticality of using combination of acetylene glycol and triethylene glycol monobutyl ether as required in the present claims.

In response, in the after-final amendment filed 5/10/04, applicants argue that one skilled in the art could not predict the effects of improving gloss differential and glossiness based on the teaching of Sano et al.

It is agreed that while Sano et al. disclose using combination of acetylene glycol and triethylene glycol monobutyl ether to produce ink with necessary penetrating capacity, there is no disclosure in Sano et al. that the combination of acetylene glycol and triethylene glycol monobutyl ether would improve gloss differential and glossiness.

However, as set forth in MPEP 2145 II, the "fact that appellant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious", *Ex parte Obiaya*,

277 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Thus, although Sano et al. disclose using acetylene glycol and triethylene glycol monobutyl ether to produce ink with necessary penetrating capacity, given that Sano et al. disclose the use of acetylene glycol and triethylene glycol monobutyl ether identical to that presently claimed, it is clear that such combination would intrinsically improve gloss differential and glossiness. That is, given that there is motivation to combine either JP 112175255 or Anton et al. with Sano et al. and given that Sano et al. disclose combination of acetylene glycol and triethylene glycol monobutyl ether as presently claimed, it is clear that the use of acetylene glycol and triethylene glycol monobutyl ether in ink of either JP 11217525 or Anton et al. would intrinsically improve gloss differential and gloss as found in ink of the present invention.

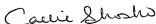
Applicants also argue that the examiner has overlooked the showing set forth in the 1.132 declaration filed 11/12/03 regarding using the claimed emulsion of sulfonyl-group containing copolymer in combination with claimed ultra-penetrating agents. The declaration compares ink within the scope of the present claims (Ink Set A), i.e. comprising emulsion of sulfonyl-group containing copolymer, acetylene glycol, and triethylene glycol monobutyl ether, with ink outside the scope of the present claims (Ink Set F), i.e. comprising acetylene glycol and triethylene glycol monobutyl ether but no emulsion of sulfonyl-group containing copolymer. It is shown that the ink of the present invention is superior in terms of cohesion, gloss differential, glossiness, bronzing, and fixing ability.

However, it is the examiner's position that the declaration is not successful in establishing unexpected or surprising results over the cited prior art given that each of the

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primary references, i.e. JP 112175255 and Anton et al., already disclose the use of sulfonyl-group containing polymer.

While it is agreed that there is no disclosure in Sano et al. of sulfonyl-group containing polymer, it is noted that note that Sano et al. is used as teaching reference, and therefore, it is not necessary for this secondary reference to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973), *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather this reference teaches a certain concept, namely the use of combination of acetylene glycol and triethylene glycol monobutyl ether in ink jet inks and in combination with the primary reference, discloses the presently claimed invention.



Callie E. Shosho
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Art Unit 1714

CS
5/25/04